UNITED STATES PATENT AND TRADEMARK OFFICE

H·A

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,064	02/20/2002	Akira Kumomura	16869S-043700US	2357

20350   7590   10/16/2006

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER
JACKSON, MICHAEL SCOTT

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-11_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-11_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    . Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All   b) ☐ Some *   c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _See Continuation Sheet_.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :2/20/2002,
5/16/2002,and 5/26/2004.

DETAILED ACTION

1. Examiner requests applicant provide an English copy of Kobayashi, et. al. JP 2001-256388.

Specification

2. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

3. The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following is a typical passage from the specification: "However, with the conventional technique such as mentioned above, it is impossible to effectuate management concerning the issue of coupons such as issue of coupon in conformance with the desire of the user, setting of the conditions for issuing the coupon on a user-by-user basis." The disclosure is replete with similar passages, suggesting a possibility of a machine translation from the original. Applicant is required to submit an amendment, which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art. Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the

disclosure as originally filed). A shortened statutory period for reply to this

action is set to expire ONE MONTH or THIRTY DAYS, whichever is longer,

from the mailing date of this letter.

Claim Rejections - 35 USC § 112

4. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent

   form for failing to further limit the subject matter of a previous claim.

   Applicant is required to cancel the claim(s), or amend the claim(s) to place the

   claim(s) in proper dependent form, or rewrite the claim(s) in independent

   form. MPEP §2164.08[R-2].

5. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent

   form for failing to further limit the subject matter of a previous claim.

   Applicant is required to cancel the claim(s), or amend the claim(s) to place the

   claim(s) in proper dependent form, or rewrite the claim(s) in independent

   form. MPEP §2164.08[R-2].

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102

   that form the basis for the rejections under this section made in this Office

   action:

   A person shall be entitled to a patent unless –

   (b) the invention was patented or described in a printed publication in this
   or a foreign country or in public use or on sale in this country, more than
   one year prior to the date of application for patent in the United States.

7. Claims 1-7, and 11 are rejected under 35 U.S.C. 102(b) as anticipated by

    Humble U.S. Patent No. 4,949,256(Reference B on attached PTO-892).

8. As per claim 1, Humble teaches a coupon information system for issuing

    coupon information in accordance with a user's request, comprising: a server

    (column 4, lines 48-49) including storing means for storing coupon

    information to be issued (column 4, line 58), and issuing means for issuing

    the coupon information (column 3, lines 32-34) in response to a request

    (column 6, lines 57-58) for issuing said coupon information in conformance

    with conditions for issue in the case where said conditions for issue are set

    previously in conjunction with the coupon information to which said issue

    request is directed; a receiver including receiving means (column 4, lines 52-

    53-41) for receiving the coupon information issued by said service providing

    server and a display means for displaying (column 4, line 64) said received

    coupon information; and a user terminal (column 4 line 58) for downloading

    for storing therein the coupon information displayed by said receiver in

    accordance with selection of the user. Examiner has interpreted the claim to

    comprise a serve with means for storing and issuing information in response

    to a request, a receiver with means for receiving and displaying the received

    information and a terminal. The server being a service-providing server is

    treated as non-functional descriptive material, as is the coupon information.

    At the time of the invention, it was well known by those in the art that a device

    capable of displaying text or image information would have been capable of

    displaying a coupon. Server is herein defined as "any device that is connected

to a network and provides a service, such as printing or file storage and
retrieval, in response to requests from computers connected to the
network."(Reference W on attached PTO-892) Humble notes "it will also be
appreciated by those skilled in the art that the difference between that which
is referred to as a peripheral and that which is referred to as an independent
device is also largely a matter of convenience and definition" (column 6, lines
19-23). Similarly, It is well known by one skilled in the art at the time of the
invention that a terminal by definition is comprised of "an input/output
device, consisting of a keyboard and a monitor, commonly used with multi-
user systems. A terminal lacking its own central processing unit (CPU) and
disk drives is called a dumb terminal and is restricted to interacting with a
distant multi-user computer, such as a mainframe. A smart terminal, on the
other hand, has some processing circuitry and, in some cases, a disk drive so
that one can download information and display it later. A personal computer
is a terminal when it is connected to a network, by either a cable or a
modem."(X on attached PTO-892)

9. As per claim 2, Humble teaches a coupon information system for issuing
   coupon information in accordance with a user's request, comprising: a server
   (column 4, lines 48-49) including first storing means (column 5, line 38), for
   storing coupon information to be issued and transmitting means (column 5,
   line 40) for transmitting the coupon information stored in said first storing
   means; and a receiver (column 5, line 40) including second storing means
   (column 5, lines 39-40), for storing conditions for issuing the coupon (column

5, lines 49-51) information desired by the user request (column 6, lines 57-58) and issuing means for making decision as to whether or not said coupon information transmitted from said server satisfies said conditions for issuing said desired coupon information, to thereby issue said coupon information transmitted from said server when said conditions are satisfied. Storing means in the case of the instant application consists of a database, taught by Humble (column 3, line 21).

10. As per claim 3, which depends on claim 2 and retains all the limitations thereof, Humble teaches a coupon information system comprising a server (column 4, lines 48-49), transmitting information (column 3, line 42) to the receiver (column 6, lines 10-13). Storing means in this case consists of a database (column 3, line 21), which is well known in the art to store multiple types of data; thus, advertisement or coupon data would not be given patentable weight and thus construed as non-functional descriptive material.

11. As per claim 4, Humble teaches storing a plurality of coupon information (column 3, line 6) displaying that information selected by the user (column 7, lines 62-65), and acquiring other coupon information (column 8 lines 9-19) and sorting (column 8, lines 42-43) and displaying sorted information (column 7, lines 62-68). Attribute information related to a coupon is construed as the discount value, expiration date, etc. is expressly taught in Humble (column 7, line 35) and would be an inherent requirement of Humble in order for the invention to function as described. As noted earlier, terminals by definition incorporate display means, and in addition, Humble expressly

teaches such displaying means (column 7, line 18; column 6, line 67-68 "incorporation herein by reference").

12. As per claim 5, which depends upon claim for and retains all the limitations thereof, Humble teaches a displaying method according to claim 4 wherein the attribute information represents validity terms (column 7, lines 39-44).

13. As per claim 6, Humble teaches a displaying method according to claim 4, wherein the attribute information is discount values (column 3, lines 67-68). These discount or credit values are commonly known in the art and therefore would not have patentable weight.

14. As per claim 7, Humble teaches a method of storing a plurality of coupon information (column 3, line 6) displaying that information selected by the user (column 7, lines 62-65), and acquiring other coupon information (column 8 lines 9-19) and sorting (column 8, lines 42-43) and displaying sorted information (column 7, lines 62-68) on the same screen (column 9, lines 1-3).

15. As per claim 11, Humble teaches a coupon information system comprising a server (column 4, lines 48-49) for receiving coupon information to be issued from a concerned enterprise together with advertisement information of said concerned enterprise, to thereby transmit information (column 3, line 42) to a receiver (column 6, lines 10-13) including a display (column 7, lines 62-68) and storing means for storing the information (column 3, line 21) and a user terminal including storage (column 3, line 6) and display (column 7, lines 62-65).

16. Claims 8-11 are rejected under 35 U.S.C. 102(b) as anticipated by Von Kohorn

U.S. Patent No. 5,128,752 (Reference A on attached PTO-892).

17. As in claim 8, Von Kohorn teaches a method of displaying information

selected by a user comprising the steps of : storing a plurality of information

(column 10, lines 67-68), extracting information selected by the user (column

10, lines 65-66), reading information (column 11, lines 9-10), decided whether

or not to display the extracted information and displaying the information

(column 10, line 55).   Von Kohorn expressly applies his invention to coupon

information (column 1, line 64) and utilizes the terms coupon as a subset of

token (column 4, lines 3-5) and the information stored related to coupons or

tokens to include redemption data (column 3, lines 60-64).

18. As in claim 9, Von Kohorn teaches the method of claim 8 further limited by

updating the coupon information (column 12, lin3 33) where maintaining a

cumulative record requires and obviates updating coupon information.

19. As in claim 10, Von Kohorn teaches the method of claim 9 further including a

remaining number of times displayed (Column 7, lines 19-21) accomplished in

Von Kohorn via pre-numbered serial numbers used to prevent counterfeiting

as in the instant application.

20. As in claim 11, Von Kohorn teaches a server (column 2, lines 30-31),

transmitting information to a receiver including a display with storage

(column 2, lines 53) and a use terminal with storage and a display (column 2,

lines (column 2, lines 35-36).

21. Claim 1-3 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by Kawaguchi, et.al. (Reference N on attached PTO-892).

22. As per claim 1, Kawaguchi, et. al. teaches an information issuing system comprising a server (column 1, lines 11-12) including storage means (column 4, line 58), issuing means (column 5, line 26), a receiver including receiving means (column 5, lines 16) and displaying means for displaying said received information and a user terminal for downloading for storing therein information displayed by said receiver in accordance with selection of the user (column 5, line 5). It is well known by one skilled in the art at the time of the invention that a terminal by definition is comprised of "an input/output device, consisting of a keyboard and a monitor, commonly used with multi-user systems. A terminal lacking its own central processing unit (CPU) and disk drives is called a dumb terminal and is restricted to interacting with a distant multi-user computer, such as a mainframe. A smart terminal, on the other hand, has some processing circuitry and, in some cases, a disk drive so that one can download information and display it later. A personal computer is a terminal when it is connected to a network, by either a cable or a modem."(Reference X on attached PTO-892)

23. As per claim 2, Kawaguchi, et. al. teaches an information issuing system comprising a server (column 1, lines 11-12) including first storage means (column 1, line 14), a receiver including receiving means (column 5, lines 8-9) including second storage means (column 6, line 19) and issuing means (column 5, line 38-40). The act of receiving information necessitates the

presence of both a transmitting means for transmitting information and a

receiver for receiving the transmitted information, and this information must

be presented to either a user or another component of the device for storage

or display in order for any further action or useful outcome to proceed.

Kawaguchi, et. al. also teaches storing electronic assets in multiple mobile and

stationary terminals (column 58, lines 50-54).

24. As per claim 3, which depends from claim 2 and retains all the limitations

thereof, Kawaguchi, et. al. teaches all the elements of claim 2 with the

additional limitation of transmitting information (column 5, line 9) and

storing said transmitted information (column 6, lines 18-19). It would be well

known to one skilled in the art that storing means may be utilized to store

multiple pieces of information independently of one another. The electronic

asset of Kawaguchi, et. al. is construed to include coupons, which are

inherently advertisements and thus advertisement information.

25. As per claim 11, Kawaguchi, et. al. teaches an information system, comprising:

a server for receiving information to be issued from a concerned enterprise

together with advertisement information of said concerned enterprise server

(column 1, lines 11-12), to thereby transmit information through digital

broadcasting (column 5 , line 21), a receiver including a display for displaying

(column 5 line 15), storing means for storing information (column 6, line 19),

and a user terminal including a storage for storing information (column 24,

lines 29-34) and a display for displaying said stored information (column 24,

line 45). In this instance the portable user terminal is defined as a portable

cellular phone; a handy terminal such as a personal digital assistance, or a notebook computer, or like device ..." (column 24, line 29-34). It was well known in the art at the time of the invention that such devices were routinely equipped with on-board memory, keyboards and displays as evidenced by Sprint PCS digital phones/network (Reference U on attached PTO-892) available in 1998 and features requiring storage and display means (Reference V on attached PTO-892).

26. Claim 7 is rejected under 35 U.S.C. 102(b) as anticipated by Greenberg, et. al. (Reference 5 on May 26, 2002 IDS).

27. As per claim 7, Greenberg, et. al. teaches a coupon information displaying method of displaying coupon information selected by a user, comprising the steps of: storing a plurality of coupon information (p. 2, line 18), displaying coupon information (p. 7, line 5), acquiring other coupon information (p. 4, line 11) and displaying acquired coupon information (p. 11, lines 10-18) and displayed coupon information on the same screen (p. 7, line 6).

28. Claims 8-9 are rejected under 35 U.S.C. 102(b) as anticipated by Lee, et. al. (Reference 6 on May 26, 2002 IDS).

29. As per claim 8, Lee, et. al. teaches a coupon information displaying method of displaying coupon information selected by a user, comprising the steps of: storing a plurality of coupon information (p. 36, line 8), extracting coupon information selected by the user from said plurality of the stored coupon information (p. 37, line 19), reading information (p. 37, line 21), deciding

whether or not said extracted coupon information is capable of being

displayed, and displaying said coupon information (p. 37, lines 7-9).

30. As per claim 9, which depends from claim 8 and retains all the limitations

thereof, Lee, et. al. teaches all the limitations of claim 8 and the subsequent

limitation of where said coupon information is updated (p. 6, lines 20-24).

Conclusion

Any inquiry concerning this communication or earlier communications

from the examiner should be directed to Michael S. Jackson whose telephone

number is (571) 270-1364. The examiner can normally be reached on Mon-Thurs

7:30AM - 5:00PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Patrick J. Nolan can be reached on (571) 272-0847. The

fax phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see

http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

PATRICK J. NOLAN, PH.D.
SUPERVISORY PATENT EXAMINER